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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,683	08/24/2001	David A. Burwell	JBP-566	2538

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,683

Applicant(s)

BURWELL ET AL.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,6,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-23, drawn to a bilayer laminate personal care article, classified in class 428, subclass 138.
 - II. Claim 24, drawn to the method of using the bilayer laminate personal care article, classified in class 15, subclass various.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such using the laminated personal care article as the topsheet of a diaper.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and have acquired a separate status in the art because of their recognized divergent subject matter and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Erin Harriman on June 10, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-23. Affirmation of this election must be made by applicant in replying to this Office action. Claim 24 withdrawn

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from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Examiner's Comments

6. It is noted that Applicant has the limitation "an apertured film layer having a *smooth* side and a *rough* side" in claim 1. Applicant's have defined the "rough" side as which contains the raised protuberances and the "smooth" side as the side from which the raised protuberances originated (Applicant's specification page 3, lines 10-24). For purposes of examination an apertured film having one surface with raised protuberances, i.e. a non-flat surface, is considered to read on the limitation of having a *smooth* side and a *rough* side.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 1, 5-7 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Pelkie (5,733,628).

Pelkie discloses a breathable elastic polymeric film laminate useful in disposable products such as diapers and hygiene products (col. 1, lines 5-9). The laminate comprises an apertured elastomeric web (apertured film layer having smooth side and rough side) and a fibrous carrier material (absorbent layer laminated to smooth side of apertured film layer) (figure 2). The fibrous material can be non-woven with a basis weight from about 5 to about 150 g/m² (col. 5, lines 17-21 and col. 10, lines 43-48). The article can have a compressibility from about 5 to about 50% (col. 9, lines 55-57). The elastomeric web may comprise materials such as polyethylene (col. 5, lines 22-45).

The limitation(s) “the article is useful for providing skin care benefits” is (an) intended use limitation(s) and is not further limiting in so far as the structure of the product is concerned. “[I]n apparatus, article, and composition claims, intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. ***If the prior art structure is capable of performing the intended use, then it meets the claim.*** In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.” [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pelkie (5,733,628) in view of Daponte (4,863,779).

Pelkie discloses all the limitations of the instant claimed invention except for the claimed drapability of the laminate.

Daponte discloses a composite elastomeric material, which is suitable as bodyside cover for diapers, health care garments and materials, tissue, and a variety of industrial products (col. 2, lines 63-66). The composites may be made in the form of soft, cloth-like materials that is superior to prior art materials with respect to drape, strength, and stretch (col. 1, lines 15-18 and col. 3, lines 42-48). The composite comprises a first gatherable web, a fibrous elastic web, and a second gatherable web (figure 2A). The fibrous web is a nonwoven web with a basis weight ranging from about 15 grams per square meter to about 300 grams per square meter (col. 14, lines 35-52). The composite has a drape stiffness of 1.87 to 4 centimeters (18.7 to 40 mm). Drape Stiffness is the measure of the softness of the material, the lower the value the more drape or less stiff and thus the softer material feels to the hand. See column 27, line 60 to column 28, line 3.

Therefore, the exact drapability of Pelkie's laminate is deemed to be a cause effective variable with regard to the softness of the laminate. It would have been obvious to one having

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ordinary skill in the art to have determined the optimum value of a cause effective variable such as drape through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated by the disclosure of Daponte to have a low drape value for Pelkie's laminate because a low drape value would provide for softer laminate. One would be motivated to use a softer laminate when the laminate is used in contact with human skin in such items as diapers and hygiene products.

11. Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pelkie (5,733,628).

Pelkie discloses all the limitations of the instant claimed invention except for the claimed resiliency and bond strength of the laminate.

Pelkie further discloses, the optimum compression is about 5 to about 50% of the ambient loft of the carrier material. In certain embodiments, the resiliency of the fibers under compression, (i.e. the fact that the fibers tend to straight back up to their original shape and position they had prior to any compression at the impingement point) will force a portion of their fiber length to embed in the soft molten polymer directly beneath them. Too much compression will force too many fibers to deeply embed or distort and the desired cloth-like characteristics of the end product are lost. In addition, too much compression causes problems such as having the impingement roll bounce, which then causes proved an uneven lamination of the carrier material onto the film material. Alternatively, if too little compression is used, there is not enough force to cause sufficient embedding of the carrier materials such that the carrier material is not laminated adequately and will fall or peel of the end product. See column 9, line 46 to column

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10, line 5. Pelkie also discloses that the carrier material adheres to the elastomeric film without the use of adhesive (col. 8, lines 24-26). Pelkie also discloses that the carrier material adheres to the elastomeric film without the use of adhesive (col. 8, lines 24-26).

Since Pelkie disclose that resiliency and bond strength are related to the compression of the article the exact resiliency and bond strength are deemed to be a cause effective variable with regard to the compression of the laminate. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as resiliency and bond strength through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to optimize these values in order insure the article would have sufficient resiliency under compression and strong enough bond strength not to fall apart during use.

12. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pelkie (5,733,628) in view of Han (5,853,638).

Pelkie further discloses, it is also contemplated that various blends of resins used to formulate the film can be used to achieve the desired qualities of the end product (col. 11, lines 8-11), but does not specifically disclose the apertured film made of a blend of various molecular weight polyolefins. Pelkie also, fails to disclose the number of apertures per square centimeters and aperture diameter.

Han discloses a porous film, which is soft to the touch and processes excellent strength and biaxial stretchability, and also possesses adequate permeability and is used for the manufacture of disposable diapers, water-proof clothing, packing materials, medical supplies,

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and in many other applications as well (col. 1, lines 5-18). The film is made from a mixture of three low and medium density polyethylene resins (col. 2, lines 56-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a blend of various molecular weight polyolefins as taught by Han as the apertured web of Pelkie because to the excellent strength and stretchability achieved by Han.

Pelkie further discloses, the film can be made with different patterns of apertures having different percentages of open areas hole sizes, hole geometries, materials and surface coatings and treatments (col. 11, lines 6-8). The apertures are add to the film to impart breathability to the laminate (col. 2, lines 47-55). Therefore, the exact the number of apertures per square centimeter and diameter of the apertures are deemed to be a cause effective variable with regard to breathability of the laminate. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as the number of apertures per square centimeter and diameter of the apertures through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to optimize the number of apertures per square centimeters and diameter of the apertures depending the desired breathability level desired in the laminate.

13. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pelkie (5,733,628).

Pelkie discloses all the limitations of the instant claimed invention except for the claimed thickness of the apertured film.

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Pelkie further discloses, that in the process of making the laminate the impingement roll is spaced from at a predetermined distance from the screen form a gap there between. The preferred distance of gap between the roll and screen is determined by the thickness of elastomeric film and the carrier being laminated together. It the carrier and film are brought into contact at this gap and bonded together. See column 10, lines 6-32.

Therefore, the exact thickness apertured film is deemed to be a cause effective variable with regard to the gap between the impingement roll and the screen. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as combined thickness of the apertured film through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to optimize the thickness of the apertured film in order to insure a good contact between the film and the carrier for bonding.

14. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pelkie (5,733,628) in view of Han (5,853,638) and Daponte (4,863,779).

Pelkie discloses a breathable elastic polymeric film laminate useful in disposable products such as diapers and hygiene products (col. 1, lines 5-9). The laminate comprises an apertured elastomeric web (apertured film layer having smooth side and rough side) and a fibrous carrier material (absorbent layer laminated to smooth side of apertured film layer) (figure 2). The fibrous material can be non-woven with a basis weight from about 5 to about 150 g/m² (col. 5, lines 17-21 and col. 10, lines 43-48). The article can has a compressibility from about 5

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to about 50% (col. 9, lines 55-57). The elastomeric web may comprise materials such as polyethylene (col. 5, lines 22-45).

Pelkie further discloses, it is also contemplated that various blends of resins used to formulate the film can be used to achieve the desired qualities of the end product (col. 11, lines 8-11).

The limitation(s) “the article is useful for providing skin care benefits” is (an) intended use limitation(s) and is not further limiting in so far as the structure of the product is concerned. “[I]n apparatus, article, and composition claims, intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. ***If the prior art structure is capable of performing the intended use, then it meets the claim.*** In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.” [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02.

Pelkie fails to disclose that the apertured film is made from a blend of various molecular weight polyolefins, the drapability, the thickness of the film, the resiliency or the bond strength.

Daponte discloses a composite elastomeric material, which is suitable as bodyside cover for diapers; health care garments and materials, tissue, and a variety of industrial products (col. 2, lines 63-66). The composites may be made in the form of soft, cloth-like materials that is superior to prior art materials with respect to drape, strength, and stretch (col. 1, lines 15-18 and col. 3, lines 42-48). The composite comprises a first gatherable web, a fibrous elastic web, and a second gatherable web (figure 2A). The fibrous web is a nonwoven web with a basis weight

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ranging from about 15 grams per square meter to about 300 grams per square meter (col. 14, lines 35-52). The composite has a drape stiffness of 1.87 to 4 centimeters (18.7 to 40 mm).

Drape Stiffness is the measure of the softness of the material, the lower the value the more drape or less stiff and thus the softer material feels to the hand. See column 27, line 60 to column 28, line 3.

Therefore, the exact drapability of Pelkie's laminate is deemed to be a cause effective variable with regard to the softness of the laminate. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as drape through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated by the disclosure of Daponte to have a low drape value for Pelkie's laminate because a low drape value would provide for softer laminate. One would be motivated to use a softer laminate when the laminate is used in contact with human skin in such items as diapers and hygiene products.

Han discloses a porous film, which is soft to the touch and processes excellent strength and biaxial stretchability, and also possesses adequate permeability and is used for the manufacture of disposable diapers, water-proof clothing, packing materials, medical supplies, and in many other applications as well (col. 1, lines 5-18). The film is made from a mixture of three low and medium density polyethylene resins (col. 2, lines 56-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a blend of various molecular weight polyolefins as taught by Han as the apertured web of Pelkie because to the excellent strength and stretchability achieved by Han.

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Pelkie further discloses, the film can be made with different patterns of apertures having different percentages of open areas hole sizes, hole geometries, materials and surface coatings and treatments (col. 11, lines 6-8). The apertures are add to the film to impart breathability to the laminate (col. 2, lines 47-55). Therefore, the exact the number of apertures per square centimeter and diameter of the apertures are deemed to be a cause effective variable with regard to breathability of the laminate. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as the number of apertures per square centimeter and diameter of the apertures through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to optimize the number of apertures per square centimeters and diameter of the apertures depending the desired breathability level desired in the laminate.

Pelkie further discloses, that in the process of making the laminate the impingement roll is spaced from at a predetermined distance from the screen form a gap there between. The preferred distance of gap between the roll and screen is determined by the thickness of elastomeric film and the carrier being laminated together. It the carrier and film are brought into contact at this gap and bonded together. See column 10, lines 6-32.

Therefore, the exact thickness apertured film is deemed to be a cause effective variable with regard to the gap between the impingement roll and the screen. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as combined thickness of the apertured film through routine experimentation in the

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absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to optimize the thickness of the apertured film in order to insure a good contact between the film and the carrier for bonding.

Pelkie further discloses, the optimum compression is about 5 to about 50% of the ambient loft of the carrier material. In certain embodiments, the resiliency of the fibers under compression, (i.e. the fact that the fibers tend to straight back up to their original shape and position they had prior to any compression at the impingement point) will force a portion of their fiber length to embed in the soft molten polymer directly beneath them. Too much compression will force too many fibers to deeply embed or distort and the desired cloth-like characteristics of the end product are lost. In addition, too much compression causes problems such as having the impingement roll bounce, which then causes proved an uneven lamination of the carrier material onto the film material. Alternatively, if too little compression is used, there is not enough force to cause sufficient embedding of the carrier materials such that the carrier material is not laminated adequately and will fall or peel of the end product. See column 9, line 46 to column 10, line 5. Pelkie also discloses that the carrier material adheres to the elastomeric film without the use of adhesive (col. 8, lines 24-26). Pelkie also discloses that the carrier material adheres to the elastomeric film without the use of adhesive (col. 8, lines 24-26).

Since Pelkie disclose that resiliency and bond strength are related to the compression of the article the exact resiliency and bond strength are deemed to be a cause effective variable with regard to the compression of the laminate. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as

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resiliency and bond strength through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to optimize these values in order insure the article would have sufficient resiliency under compression and strong enough bond strength not to fall apart during use.

Conclusion

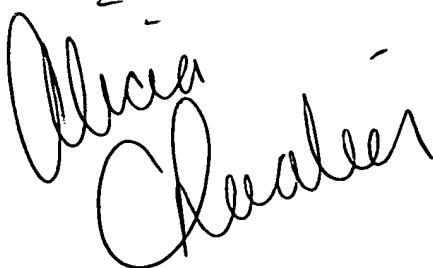
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

6/20/03

A handwritten signature in black ink, reading "Alicia Chevalier". The signature is written in a cursive, flowing style. The first name "Alicia" is on the top line, and the last name "Chevalier" is on the bottom line, with the two names connected by a continuous stroke.